

BS01396

U.S. Application No. 10/084,948 Art Unit 2192  
Response to March 23, 2005 Office Action

### **REMARKS**

In response to the Office Action dated March 23, 2005, Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents and are ready for allowance.

The United States Patent and Trademark Office (the "Office") rejected claims 1, 4, and 5 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,510,466 to Cox *et al.* in view of U.S. Patent 4,951,192 to Chase, Jr. *et al.* Claim 2 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Cox in view of Chase and further in view of U.S. Patent 6,516,337 to Tripp *et al.* Claim 3, however, would be allowable if rewritten in independent form. The Assignee has decided to accept allowable claim 3 and, thus, reduce prosecution costs. The Assignee thus respectfully submits that the pending claims are ready for allowance.

### **Rejection of Claims under 35 U.S.C. § 103 (a)**

Claims 1, 2, 4, and 5 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over various combinations of Cox, Chase, and Tripp. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P.").

Claim 1 is not obvious. Claim 1 recites features not taught or suggested by the proposed combination of Cox and Chase. Claim 1, for example, recites "a first list comprising the plurality of software releases, wherein for each software release, the first list includes a release identification and a source type." Neither Cox nor Chase describes such features. Examiner

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Kendall points to column 4, lines 35-39 of *Cox*, but the Assignee cannot agree. These lines of *Cox* describe a server that provides an instance of an application program to a client. These lines fail to describe "*for each software release, the first list includes a release identification and a source type.*" The Assignee, in fact, cannot locate any passages that recite such features. One of ordinary skill in the art, then, would not think claim 1 obvious in view of *Cox* and *Chase*. The proposed combination of *Cox* and *Chase*, then, cannot obviate claim 1.

Claims 2, 4, and 5 are likewise not obvious. These claims depend from independent claim 1 and thus incorporate the same distinguishing features. One of ordinary skill in the art, then, would not think claims 2, 4, and 5 obvious. Examiner Kendall is respectfully requested to remove the § 103 (a) rejection of claims 1, 2, 4, and 5.

### **Allowable Claim 3**

Examiner Kendall indicates that claim 3 would be allowable if rewritten in independent form. The Assignee amends claim 3 to include all the features recited in the base claim 1. Examiner Kendall is thanked for the suggestion.

### **New Claims 6-19**

This response adds new claims 6-19. Because the number of claims does not exceed twenty (20), and because the total number of independent claims does not exceed three (3), no excess claim fees are due.

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If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Scott P. Zimmerman", is written over a large, stylized "X" or "S" mark.

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